

REMARKS

Claims 3, 5, 7, 24 and 28 have been amended. Accordingly, Claims 1-30 are pending in the application. The reconsideration of the application is respectfully requested.

On the merits, Claims 1-30 were rejected under 35 U.S.C. Section 103(a) as being obvious under Lamm in view of Kolling et al., Walker and PR NewsWire (a total of four references). Lamm provides a purely electronic EBPP system in which electronic bill files are redacted and reconstructed (by removing, deleting, or editing the billing information) for presentment to the customer by selecting certain information from the electronic bill and adapting (e.g., inserting standard bill components) the billing information for presentment to the customer. Similarly, Kolling et al. discloses a purely electronic statement presentment system to replace the preparation and mailing of paper statements, *i.e.*, to replace the printing, stuffing, and mailing of paper statements with electronic delivery (emphasis added) (see Kolling et al., column 4, lines 16-18).

With regard to the news articles cited by the Examiner, Walker briefly discusses an integrated billing system with a high-level architecture that converts a single electronic print stream from existing billing systems, routes and transforms the customer's bills based on the delivery preference of the customer (using the electronic print stream to produce paper bills or electronic bills). In even fewer words, PR Newswire reports about a business transaction of a company that specializes in the bill processing, scanning, and data entry to ensure timely processing of customer bills.

Impermissible Hindsight-based Obviousness

The Section 103(a) rejection is improper due to the use of impermissible hindsight-based obviousness. As a defense against such hindsight-based obviousness allegations by an examiner, the Federal Circuit has insisted on the existence of a valid reason to make the combination. What the Examiner did in the Section 103(a) rejection is to use the highly innovative and novel solution taught by the Applicants as a blueprint, with the Lamm reference as the main structural diagram, the Kolling et al. reference for the scanning element present in the claim but missing from the primary reference and the Walker and PR Newswire references for disclosing transmitting paper and electronic bills to customers as they desire. This is impermissible, as the Federal Circuit has noted in case after case. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

The proper analysis is whether there is something in one of the prior art references which are being combined which suggests the combination, and in the Section 103(a) rejection based on Lamm, Kolling et al., Walker and PR Newswire, the Examiner failed to find such a teaching or suggestion supporting the combination. The Examiner's Section 103(a) rejection is textbook example of improper combination of prior art references, saying little more than that it was obvious to make the combinations because the combinations were obvious.

MPEP Section 2143.01 states that there must be a suggestion or motivation in the references to modify or combine the references even if the references may be capable of being modified to run the way the present invention is claimed. However, the motivation to combine one (or more) of Lamm, Kolling et al., Walker, and PR Newswire cannot come from Applicants' Application. Applicants submit that only through impermissible hindsight would one modify Lamm by combining it with Kolling et al., Walker and PR Newswire (a total of four references) to meet the limitation of the claims of the present invention.

Knowledge of Applicants' disclosure must be put aside in reaching the obviousness determination. Applicants respectfully acknowledge that the tendency to resort to "hindsight" based upon Applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, the Examiner in this case exercised impermissible hindsight. The Examiner's conclusion was reached on the basis of facts gleaned from improper prior art and thus, the Section 103(a) rejection of the claims should be withdrawn.

References Cited are Not Enabling

The non-patented literature cited by Examiner, the Walker article and particularly the news release from PR Newswire, do not satisfy the enablement provision of 35

U.S.C. Section 112, first paragraph. In other words, the Walker article and PR Newswire news release did not adequately disclose the claimed invention of Applicants. The Walker reference merely reported on the trends in bank systems and technology. Further, the trends and company news release from non-patented literature do not enable a person of ordinary skill in the relevant art to make and to use the invention without "undue" experimentation. The PR Newswire news release simply reported the business transactions and partnerships of the National Processing Company ("NPC"). The primary function of the Walker article was to discuss trends in the industry, and the primary function of PR Newswire news release was to inform the public, particularly investors, of NPC's businesses. Thus, the non-patented literature do not satisfy the enablement provision of Section 112 and the Section 103(a) rejection of the claims based on these references should be withdrawn.

References Teach Away

Teaching away is the antithesis of the art's suggestion that one of ordinary skill in the art move in the claimed direction. Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. Furthermore, MPEP Section 2144.05 affirms that "[a] prima facie case of obviousness ... [is] rebutted by showing that the art, in any material respect, teaches away from the claimed invention."

Lamm teaches away from paper billing and wants to replace the use of existing paper bills and check to reduce the printing, processing, and postage costs of paper billing

("The system should replace the use of existing paper bills and checks to reduce the printing, processing, and postage costs of paper billing." Lamm, column 3, lines 62-64). Similarly, Kolling et al. also teach away from the present invention by providing a "system [which] replaces the preparation and mailing of paper statements and invoices from biller with electronic delivery" (Kolling et al., Abstract; see also, column 4, lines 16-18 "The present invention replaces the printing, stuffing, and mailing of paper statements with the power and efficiency of electronic delivery."). The system of Kolling et al. does not accommodate paper bills because Kolling et al. assert that the features provided by Kolling et al. "are not possible in the traditional paper-based process that uses either the post office or a courier to deliver paper statements" (Kolling et al., column 4, lines 47-49).

With regard to the Walker reference, Walker discloses the conversion of an electronic print stream to a paper bill or an electronic bill. Thus, Walker effectively teaches away from receiving a paper bill and scanning the paper bill. Walker discloses an integrated system that only receives electronic print stream (emphasis added).

With regard to PR Newswire, the news release reports that NPC specializes in bill processing, scanning and data entry of customer bills, exclusively for billers. In other words, NPC services billers via a processing center where customer payments are processed. Thus, NPC deals exclusively (with regard to the content of the news release) with receiving payments via the postal system. The one use of "scanning" in the PR Newswire news release most likely deals with imaging payments from customer to

provide a record to billers. Perhaps even more fundamentally than teaching away, the business of NPC is totally unrelated to and is not germane to the present invention. For example, the Examiner is respectfully invited to visit NPC's homepage at <http://www.npc.net> in which NPC discusses, via the corporate information webpage, providing strategic outsourcing services for businesses. There is no mention of the process of the present invention in the entire NPC website.

Based on the foregoing, it is submitted that Lamm, Kolling et al., Walker and PR Newswire do not provide a basis for combining the teachings of the references because all four references plainly teaches away from the present invention. Therefore, Applicants respectfully submit that the 103(a) rejection of the Claims should be withdrawn.

The References Do Not Teach or Suggest Each and Every Limitation

Perhaps even more fundamentally, the Section 103(a) rejection of the claims on the combination of the Lamm, Kolling et al., Walker, and PR NewsWire fails to teach the claimed combination, meaning that the references do not teach or suggest each and every limitation of the claims.

Claim 1 distinguishes over Lamm, Kolling et al., Walker and PR Newswire by including features relating to the receiving, scanning, extraction, validation and presentation of billing information derived from paper-based bills. Applicants emphasize that all of the above steps relate to paper bills and the paper billing process.

In previously office actions, the Examiner conceded that Lamm does not disclose the scanning step and, essentially, does not accept paper bills. Applicants further assert that Lamm does not disclose the identification of content step, the identification of bill type step, the extracting of billing information step, validation step, and the presentment of extracted bill step.

Kolling et al. do not cure the deficiencies of Lamm. Kolling et al. do not accept paper bills. The Adobe software disclosed by Kolling et al. is used with the template authoring workstation to create electronic bill statements (Kolling et al., column 10, line 7; see also column 9, lines 49-67). Kolling et al. do not disclose identifying the contents of the paper bill or extracting billing information using a predefined template. In addition, Kolling et al. do not validate the extracted billing information. No where in the Kolling et al. patent does it mention even receiving a paper bill.

Walker briefly discusses a high-level architecture that converts a single print stream (which is electronic data) from billers and delivers customer bills based on delivery preferences of the customers. Walker does not receive paper bills. Therefore, Walker does not identify the content of the paper bill, scan the paper bill, extract billing information from the paper bill and validate the extracted information from the paper bill.

The news release from PR Newswire is nonenabling and irrelevant and lacks every novel steps of Claim 1. As mentioned above, the identified company, NPC, engages in servicing businesses by providing a processing center through which business can

outsource processing of customer bills, *i.e.*, customer payments. Thus, NPC receives and processes bill payments from customers for billers.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm, Kolling et al., Walker nor PR Newswire, whether taken singly or combined, teach or suggest each and every limitation of independent Claim 1. It is submitted that Claim 1 clearly distinguishes over Lamm, Kolling et al., Walker and PR Newswire and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Claims 2-8 are dependent upon Claim 1 and are believed to be patentable with the parent Claim 1.

Claim 9, recites the steps of receiving, scanning, extracting, validating, and presenting billing information derived from paper bills in a manner similar to Claim 1, and thus, distinguishes over cited references for the same reasons given above. In addition, Claim 9 further distinguishes over the cited references by reciting the step of receiving and processing a paper bill and extracting an image of the payment remittance stub from the paper bill. None of the cited references teach or suggest the use of the payment remittance stub derived from the paper bill.

Thus, it is respectfully submitted that the cited references, whether taken singly or combined, do not teach or suggest each and every limitation of independent Claim 9.

Claim 9 is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 10-12 are dependent upon Claim 9 and are believed to be patentable with the parent Claim 9.

Claim 13, recites the steps of receiving, scanning, extracting, validating, and presenting paper bills in a manner similar to Claim 1, and thus, distinguishes over the cited references for the same reasons given above. Claim 13 further distinguishes over the cited references by reciting extracting an image of the remittance stub, storing a scanned image of a remittance stub for the paper bills and printing the stored scanned image of the remittance stub for the paper bill.

Lamm does not disclose the step of storing the remittance stub and printing the remittance stub. Kolling et al. states that the remittance stub process "requires large amounts of time and money to process paper bills, checks, and stubs" (Kolling et al., column 2, lines 1-3). Kolling et al., therefore, effectively teach away from the use of a remittance stub as claimed (emphasis added). Walker and PR Newswire do not teach or suggest the remittance stub steps either.

Thus, the cited references, whether taken singly or combined, do not teach or suggest each and every limitation of independent Claim 13. It is submitted that Claim 13 clearly distinguishes over the cited references and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 13 under 35 U.S.C. §103(a) should be withdrawn.

Claims 14-15 are dependent upon Claim 13 and are believed to be patentable with the parent Claim 13.

Independent system Claims 16, 24 and 28 are written in a fashion similar to independent method Claims 1, 9, and 13, respectively. All arguments presented herein for Claims 1, 9 and 13 apply equally to Claims 16, 24 and 28, respectively. Therefore, in view of the distinctions and advantages as noted above with respect to Claims 1, 9, and 13, it is respectfully submitted that the cited references, whether taken singly or combined, do not teach or suggest each and every limitation of independent Claims 16, 24, and 28. It is submitted that Claims 16, 24 and 28 clearly distinguish over the cited references and are believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claims 16, 24 and 28 under 35 U.S.C. §103(a) should be withdrawn.

Claims 17-23 are dependent upon Claim 16 and are believed to be patentable with the parent Claim 16.


Claims 25-27 are dependent upon Claim 24 and are believed to be patentable with the parent Claim 24.

Claims 29-30 are dependent upon Claim 28 and are believed to be patentable with the parent Claim 28.

In summary, Claims 1-30 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such, Applicants

respectfully request entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned representative at the number listed below.

Respectfully submitted,
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